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In re Application of : DECISION ON PETITION
GOLLER, et al. :
Serial No.: 10/578,233 :
PCT No.: PCT/US04/36477 : UNDER 37 CFR 1.47(a)
Int. Filing Date: 03 November 2004 :
Priority Date: 03 November 2003 :
Atty Docket No.: TEVBNP 3.3-167 :
For: SOFT STEROID COMPOSITIONS FOR :
USE IN DRY POWDER INHALERS :
:

This decision is in response to applicant's "Renewed Petition under 37 CFR 1.47(a)" filed 04 March 2008 to accept the application without the signatures of joint inventors, Qi Li, Katherine Salas, Anayo Ukeje and Ramesh Yanamandra. Applicant requests a four month extension of time, which is granted.

BACKGROUND

On 13 June 2007, applicant filed a petition under 37 CFR 1.47(a) to accept the application without the signatures of joint inventors Qi Li, Katherine Salas, Anayo Michael Ukeje and Ramesh Yanamandra.

On 30 August 2007, a decision was mailed dismissing the petition and indicating that Petitioner had failed to provide factual proof that the nonsigning joint inventor refused to execute the application or could not be reached after diligent effort.

On 04 March 2008, Petitioner filed a renewed petition.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the nonsigning joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the

nonsigning inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Items (1) and (3) above were previously satisfied.

Petitioner has now provided a multi-page declaration executed by previously nonsigning inventors Qi Li, Katherine Salas and Anayo Michael Ukeje. Thus, the petition under 37 CFR 1.47(a) is now moot with regard to these inventors. However, the declaration, as filed, is unacceptable. The declaration is a four page declaration but is comprised of eight pages: one Page 1, and two Page 2s, three Page 3s and two Page 4s. The pages are executed by different inventors. The declaration appears to be a composite declaration created from the combination of separately executed declarations. It appears that either the attorney pieced together separate complete declarations into one composite declaration or that the inventors were presented with an incomplete declaration. Thus, the declaration is not properly executed. While it is acceptable for applicants to execute separate copies of the declaration, *the entire declaration, as executed by the inventor, must be submitted.* "Where individual declarations are executed, they must be submitted as individual declaration rather than combined into one declaration." See MPEP 201.03. The declaration is unacceptable as filed as the requirements of 37 CFR 1.497 (a) and (b) have not been met.

In support of the petition under 37 CFR 1.47(a), petitioner submits the affidavit of Payam Moradian, an associate attorney with Kenyon & Kenyon, who states that an internet search yielded an address for a Ramesh Yanamandra. Mr. Moradian states that he sent emails to the joint inventors, asking for contact information for Ramesh Yanamandra. No further information regarding Mr. Yanamandra was forthcoming.

Petitioner also submits the affidavit of Samantha Claire Radley, Patent Administrator for Norton Healthcare Limited (assignee) regarding the nonsigning inventors' refusal or unavailability to sign the application papers. Ms. Radley states that on 25 February 2008, she sent a letter accompanied by a copy of the PCT application, a Declaration and an Assignment to Ramesh Yanamandra at his last known address as listed on the published international application and the internet address located by Mr. Moradian. Ms. Radley explained that she sent the documents using overnight mail. She states that as of 28 February 2008, the delivery service made an unsuccessful attempt to deliver the documents. A message card was left at the address for the addressee indicating that a package was being held for Mr. Yanamandra. The instant petition was filed five days later. This may not be sufficient time to secure delivery and is not adequate time for the nonsigning inventor to respond.

The postal receipts presented as evidence did not demonstrate that the inventor was presented with the application papers. It is unclear that delivery ever occurred as the tracking statement only indicates that a message was left regarding arranging for the documents delivery. The nonsigning inventor's silence cannot be construed as a refusal in the immediate circumstances as it is unclear whether he received a complete copy of the application papers.¹

¹ In cases where it is argued that the non-action of an inventor should be considered a refusal to cooperate, it is especially important to provide proof of delivery of the papers, as well as, a firsthand statement of the

Thus, there is insufficient documentary evidence at this time to conclude that a complete copy of the application papers was presented to the nonsigning inventor and that he refuses to sign the application. Petitioner must provide the nonsigning inventor with a complete copy of the application papers before a petition under 37 CFR 1.47(a) can be granted.

Applicant has not presented sufficient evidence at this time to show that nonsigning inventor Ramesh Yanamandra was presented with and received a complete copy of the application papers including a declaration and that he refuses to sign or was unavailable to sign the application papers. In light of the above, Item (2) and (4) above are not yet satisfied and thus, it is inappropriate to grant applicant's petition under 37 CFR 1.47(a) at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.


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